

Remarks

Claims 1-40 are pending in the subject application. In response to the Restriction Requirement mailed September 12, 2007, Applicants hereby provisionally elect to prosecute the claims of Group I (i.e. claims 1-14, 17, 18, 22-26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl-benzamide-phenyl core), with traverse, and further elect the compound of example 10 as the single species.

Lack of Unity

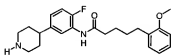
In the September 12, 2007 Office Communication, the Examiner required restriction to one of the following groups under 33 U.S.C. §121 and 35 U.S.C. §372:

- Group I. Claims 1-14, 17, 18, 22-26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl-benzamide-phenyl core as depicted in the structures of claim 4 and claim 22 only;
- Group II. Claims 1-2, 15-16, 26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl-pyridine core as depicted in the structures of claims 15 and 16;
- Group III. Claims 1-2, 17-18, 20-21, 26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl-benzamide-amino core as depicted in the structures of claim 20;
- Group IV. Claims 1-2, 17-19, 26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl- benzamide -ether core as depicted in the structures of claim 19, and all others not delineated here; and
- Group V. Claims 29-40 drawn to treating a “disorder mediated by the MCH-1 receptor” with compounds limited in scope to a single group of compounds I-III and a single “disorder”.

For Groups I-IV, the Examiner stated that an election of a single disclosed species of compound is also required and that further restriction will be made based on the election. For Group V, the Examiner stated that an election of a single disclosed species of a compound together with all other components of the treatment as well as an election of a “disorder” is required.

The Examiner asserted that a lack of unity exists, as defined in Rule 13 and stated that the instant application contains inventions or groups of inventions, which are not so linked as to form a single general inventive concept under 35 U.S.C. 121 or PCT Rule 13.1. The Examiner further asserted that a lack of a special technical is apparent since a search of the compound core resulted in numerous iterations and would not run to completion.

In order to be fully responsive, Applicants hereby elect, with traverse, the claims of Group I (i.e. claims 1-14, 17, 18, 22-26, 27 and 28 drawn to compounds, compositions and processes of making said compositions having a piperidinyl-benzamide-phenyl core). Additionally, Applicants hereby elect the compound of example 10 as the single species. The compound of example 10 is being claimed in claim 8 and has the following structure:



However, Applicants note that all of the compounds of claims 1-40 do share a common core structure, as evidenced in Claim 1. Furthermore, all of the alternatives share a common property or activity, namely, antagonism of MCH1 receptors.

Applicants also wish to direct the Examiner’s attention to the MPEP guidelines for Determination of Unity of Invention (MPEP §1850). MPEP §1850 states that lack of unity “should neither be raised nor maintained on the basis of a narrow, literal or academic approach.” The MPEP states that “if the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on independent claims.” The MPEP continues, “no problem arises in the case of a genus/species

situation where the genus claim avoids the prior art, provided the genus claim is directed only to alternatives of a similar nature and the species falls entirely within the genus.”

Regarding the Examiner’s assertion that the results of the search support the statement that a special technical feature is lacking, Applicants respectively disagree. Applicants note that the chemical structure used by the Examiner, which is disclosed on page four of the Office Communication, is open-ended. In contrast, the subject invention is directed to compounds wherein the carbon atom of the genus is limited to those substituents listed in claim 1 (i.e. the substituents allowed off the variable X). Applicants believe that if the search had been run with the limitations set forth in claim 1, the results would not have given numerous iterations and would have run to completion.

Accordingly, Applicants maintain that the lack of unity should not be raised nor maintained and respectfully request reconsideration of the restriction requirement and examination of the claimed subject matter on the merits.

If a telephone interview would be of assistance in advancing prosecution of the above-identified application, the undersigned invites the Examiner to telephone the number provided below. No fee is deemed necessary with the filing of this Communication. However, if any fee(s) is required, authorization is given to charge such fee(s) to Deposit Account No. 503201.

Respectfully submitted,

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